



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,656	12/12/2001	Gary Carlton Johnson		4604
7590	12/06/2005		EXAMINER	
Gary C Johnson 2064 Lafayette Detroit, MI 48207			WRIGHT, DIRK	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,656	JOHNSON, GARY CARLTON	
	Examiner	Art Unit	
	Dirk Wright	3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 15 and 16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 November 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

Response to Amendment

Applicant's Response filed November 17, 2005 has been carefully considered. The examiner's response to applicant's arguments can be found under the heading "***Response to Arguments***".

The amendment filed May 23, 2005 continues to be objected under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The "Detailed Description of the Invention" filed May 23, 2005, intended by applicant to replace his original "Detailed Description of the Drawings", contains new matter. The subject matter not supported by the original application, and not inherent in the original drawings, claims or description, includes the following:

Page 1, lines 7 and 8: "(4) anti roll-back means of the drive wheels./axle sections on an inclined drive surface"

Page 1, line 14: "by way of the outwardly protruding axial stock of case (8)"

Page 3, lines 9-10: "The axle section of axle 10; being/beginning at 0 rpm."

Page 3, lines 11-12: "The said new differential is designed to automatically go into a gear-locking effect/mode. The above said axle section, of axle 10; being/beginning at 0 rpm."

Page 4, lines 2-3: "Herein the axle section of axle 5; being/beginning at 0 rpm."

Page 4, lines 4-6: "In the above said circumstance, the said; new differential is designed to automatically go into a gear-locking effect/mode. Whereas gear 6, of axle 5, is also at 0 rpm."

Page 4, line 8: "Whereas gear 12, of axle 5, is also at 0 rpm;"

Page 4 line 11: "Hereby causing the afore said; gear-locking effect/mode."

Page 4, lines 14-16: "(d) wherein traction is lost by one of either axle section; on an inclined drive surface. Herein a situation called; "vehicle roll-back" will occur. The afore mentioned gear-locking effects/modes;"

None of these features were present in the originally filed application, and are not inherent from the original claims, specification or drawing.

In the claims, the following is deemed to be new matter:

In claim 15:

line 4: "a means of only allowing/forcing both drive axles/wheels to rotate in unison,";

line 7: "...disallows the over-spinning of the both drive wheels...";

line 15: "the said differential also having inherent Posi-Traction and an inherent anti roll-back features for the vehicle when in a racing/climbing mode,";

line 18: "...because of the roll-over tendencies of these said vehicles,"; and

line 30: "a smooth rounded inner surface throughout it's central stock,".

None of these claimed features are supported by, or inherent from, the original specification, claims or drawing.

The proposed replacement drawings were received on November 12, 2004. These drawings are unacceptable and will not be entered because they contain new matter. The new matter includes the added support stock (not labeled) protruding from axial sides of the differential case (8).

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification Objected

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 15:

line 20: “a differential drive case”;
line 21: “a first and second planetary differential gear”;
line 24: “a support structure/drive case”;
line 24: “two sun gears”;
line 24: “at least one planet wheel”;
line 25: “one input shaft”;
line 25: “two output shafts”;
line 51: “freely rotatable bevel pinion”; and
line 53: “differential side bevel gears”.

None of these phrases are found in the original specification, claims or drawing.

Claims Rejected

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 15:

line 4: "a means of only allowing/forcing both drive axles/wheels to rotate in unison;";

line 7: "...disallows the over-spinning of the both drive wheels...";

line 15: "the said differential also having inherent Posi-Traction and an inherent anti roll-back features for the vehicle when in a racing/climbing mode,";

line 18: "...because of the roll-over tendencies of these said vehicles,"; and

line 30: "a smooth rounded inner surface throughout it's central stock;".

None of these claimed features are supported by, or inherent from, the original specification, claims or drawing and therefore it appears that applicant did not possess these claimed features at the time this application was filed.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/254,901, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112

for claims 15 and 16 of this application. The provisional application does not show the same differential as applicant has claimed; in particular at least the input shaft 19, as recited in the claims, is not shown in the provisional drawings.

Response to Arguments

Applicant's arguments filed November 17, 2005 have been fully and carefully considered.

In response to his point (1) on page 1 of his Remarks - A, applicant states that he was never informed that his application was missing a required part. The examiner never required applicant to submit a new "Detailed Description of the Invention". Applicant volunteered it on March 16, 2004. No marked up copy is required, however the addition of new matter to the specification is prohibited by statute. The examiner has suggested that applicant hire an attorney, and also provided an outline of a proper patent application in the Action of June 28, 2005.

In response to his point (2) on page 1 of his Remarks - A, applicant states that the examiner was in error in his rejection under 35 U.S.C. 112, first paragraph. The rejection has been corrected.

In response to his point (1) on page 2 of his Remarks - B, applicant objects to the examiner's statement: "have a function where an axle was rotated at 0 rpm". The basis for this statement is from Applicant's Detailed Description of the Invention, page (3), lines 10, and 12, and page (4) lines 3, 6, and 8.

In response to his point (2) of page 2 of his Remarks - B, applicant appears to argue that the fact that he did not specify that the input shaft 19 had "a smooth rounded inner surface" and that his drawings did not exclude such a feature, that the addition of this feature should not be

Art Unit: 3681

new matter. This is not found persuasive because the characteristic texture of the inner surface of the shaft is not evident from the drawings or the specification, and adding such a feature would therefore be new matter.

In response to his point (3) of page 2 of his Remarks – B, applicant appears to be asserting that because the “outward protruding axial stock” is obvious to one of ordinary skill in this art, it can’t be considered new matter to add it to the drawing. This is not found persuasive because every change made to the drawings that is not specifically and explicitly supported by the specification is considered new matter.

In response to his Remarks – C concerning the replacement drawing, applicant appears to be stating that because the examiner has objected to the drawings again, applicant feels obligated to assert that he has support for the bevel gear 12 being splined to shaft 5. Since the examiner does not maintain that objection about the drawings, applicant’s argument appears to be moot.

In response to his Remarks – C concerning the inherent functions, theories or advantages, MPEP 2163.07(a), applicant appears to be stating that he has already disclosed the newly recited features that the examiner has deemed as new matter, and therefore the newly recited features are not new matter. He goes on to cite apparent phrases from his original disclosure in support of his position. This is not found persuasive because it is not clear to which rejection or objection his arguments pertain. The fact that his original paragraph [0003] recited gears does not mean that he has antecedents for: In claim 15:

line 20: “a differential drive case”;

line 21: “a first and second planetary differential gear”;

line 24: “a support structure/drive case”;

Art Unit: 3681

line 24: "two sun gears";

line 24: "at least one planet wheel";

line 25: "one input shaft";

line 25: "two output shafts";

line 51: "freely rotatable bevel pinion"; and

line 53: "differential side bevel gears".

The recitation from paragraph [0006] "...will only allow diametrical wheel/axle section roll-back" does not appear to support an anti-roll back feature found in claim 15, line 15. The phrase is confusing and indefinite. Further, his recitation of the phrases from the other paragraphs does not appear to support: In claim 15:

line 4: "a means of only allowing/forcing both drive axles/wheels to rotate in unison,";

line 7: "...disallows the over-spinning of the both drive wheels...";

line 15: "the said differential also having inherent Posi-Traction and an inherent anti roll-back features for the vehicle when in a racing/climbing mode,"; and

line 18: "...because of the roll-over tendencies of these said vehicles,".

Applicant has made a number of requests on page 4 of his Response. Request (1) has been complied herewith. Request (2) does not appear to be a request. Request (3) is confusing because no claim in this application has been found to be allowable. In order for an applicant's invention, as defined by his claims, to be deemed allowable, it must not be rejected under any statute. Such is not the case in this application. The examiner stated in the Action of June 28, 2005:

“A determination as to the patentability of the claims over the prior art cannot be determined until the rejection under 35 U.S.C. 112, second paragraph, is overcome, as well as the objections to the amendment and drawing change are overcome, however applicant appears to be claiming enough subject matter in clear enough language that it appears that none of the cited prior art anticipates or renders obvious applicant's invention.”

It is also not clear as to why applicant would assume that an application becomes “Special” based upon the above paragraph. This application has been treated with the proper expediency ever since it was filed.

As to Applicant's Request (4), applicant should know that provisional applications normally expire after 12 months unless applicant takes the required steps to make the application non-provisional. See 35 U.S.C. 111(b)(5) and MPEP 201.04(b). Also see MPEP 201.11 for the requirements for benefiting from a claim of priority under 35 U.S.C. 119(e). In particular, applicant did not comply with the requirement that the later-filed application must contain a reference to the prior-filed application in the first sentence(s) of the specification or in an application data sheet for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e), and applicant also did not comply with the requirement that if the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e). Applicant's Request (4) is therefore denied.

In regards to applicant's preamble, it is not clear what exactly applicant is asserting at the bottom of page 4.

In regards to applicant's Statement of Incorporation by Reference on page 5 of his Response, the request is denied because it would introduce new matter into the disclosure. The disclosure of the prior-filed application, Application No. 60/254,901, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 15 and 16 of this application. The provisional application does not show the same differential as applicant has claimed; in particular at least the input shaft 19, as recited in the claims, is not shown in the provisional drawings.

Applicant's "Statement of Irreparable Damage" is noted.

Suggested Allowable Claim

This application would be allowable if the following claim were added by amendment, and if the original "Summary of the Invention" were amended to contain all of the language of the below claim, if the original "Detailed Description of the Drawing" were amended to provide the proper antecedents for the new claim language, if claims 15 and 16 were cancelled, and if applicant dropped all previous amendments, drawing changes, requests and statements:

"A differential comprising:

a rotatable housing (8);

at least one pinion shaft (3) fixed to said housing;

one bevel pinion gear (13) rotatably mounted on said pinion shaft;

said one bevel pinion gear meshing with first (12) and second (11) side bevel

gears;

first (5) and second (10) coaxial output shafts rotatable supported by the housing; said first side bevel gear (12) and a first sun gear (6) rotatably fixed to said first output shaft;

said second side bevel gear (11) rotatably fixed to a planetary gear carrier (9); a second sun gear (7) rotatably fixed to a hollow intermediate shaft (19); said intermediate shaft disposed coaxial with the first output shaft and rotatably fixed to said at least one pinion shaft (3);

at least one planet gear (16) rotatably supported by a planet gear shaft (17) and meshing with both said first and second sun gears;

said planet gear shaft supported by said planet carrier;
and said second output shaft (10) rotatably fixed to said planet carrier.”

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dirk Wright whose telephone number is 571-272-7098. The examiner can normally be reached on Monday through Friday, 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dirk Wright
Primary Examiner
Art Unit 3681

DW
Monday, November 28, 2005

